

REMARKS

Claims 1-33 are pending in this application. By this Amendment, claims 1 and 33 are amended. No new matter has been added.

Support for the amendments to claims 1 and 33 is found, for example, on page 3, line 31 – page 4, line 2; page 4, lines 11-16; and Figs. 1 and 2.

Entry of the amendments is proper under 37 C.F.R. §1.116 as the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issues requiring further search and/or consideration as the amendments amplify issues previously discussed throughout prosecution; and (c) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection. Entry of the amendments is thus respectfully requested.

It is noted that claims 4-6, 8-9 and 12-28 are not rejected over any applied art. They are allowable once the 35 U.S.C. §112, first and second paragraph rejections are obviated, as is the case.

I. REPLY TO REJECTIONS

On page 2, item 2 of the Office Action, claims 1-33 are rejected under 35 U.S.C. §112, first paragraph as allegedly failing to comply with the enablement requirement. Claims 1 and 33 are amended to obviate the rejection. Withdrawal of the rejection is respectfully requested.

On page 2, item 4 of the Office Action, claims 1-33 are rejected under 35 U.S.C. §112, second paragraph as allegedly being indefinite. Claims 1 and 33 are amended to obviate the rejection. Withdrawal of the rejection is respectfully requested.

On page 3, item 6 of the Office Action, claims 1-3, 7, 10, 11 and 30 are rejected under 35 U.S.C. §102(b) over U.S. Patent No. 5,348,123 to Takahashi et al. (hereinafter "Takahashi"). The rejection is respectfully traversed.

Applicants respectfully submit that Takahashi fails to disclose an actuator, comprising . . . a drive comprising a motor, . . . wherein at least a rotatable component of the drive is rotatably supported on the screw which is rotatably supported relative to the housing, and the rotatable component of the drive is a rotor of the motor, said rotor being coaxial with respect to the screw, as recited in claim 1.

As shown in Fig. 3, Takahashi discloses its motor 3 is fixed onto the frame body 2a, and a plane gear wheel 4a is mounted onto the motor shaft of the motor 3 (col. 4, lines 19-21). It is clear from Fig. 3 of Takahashi that Takahashi fails to disclose the features recited in claim 1, namely a rotatable component of the drive (which is a rotor of the motor) is rotatably supported on the screw, or the rotor being coaxial with respect to the screw. Instead, Takahashi discloses motor 3 fixed onto the outside of the frame body 2a on the upper side of the frame body 2a. Further, because of this placement on the outside and the upper side of the frame body 2a, the motor 3 and its rotor cannot be coaxial with respect to the screw.

Consequently, claim 1 is patentable over the applied reference. Claims 2, 3, 7, 10, 11 and 30, which depend from claim 1, are likewise patentable over the applied reference for at least the reasons discussed above and for the additional features they recite. For example, Takahashi fails to disclose a support bearing of claim 2 or an auxiliary bearing of claim 3. Takahashi discloses a key 108. Withdrawal of the rejection is respectfully requested.

On page 4, item 8 of the Office Action, claim 33 is rejected under 35 U.S.C. §103(a) over Takahashi.

Corresponding to the discussion above for claim 1, claim 33 similarly recites a brake calliper for a disk brake, comprising . . . a drive comprising a motor, . . . wherein at least a

rotatable component of the drive is rotatably supported on the screw which is rotatably supported relative to the housing, and wherein the rotatable component of the drive is the rotor of the motor, said rotor being coaxial with respect to the screw, as recited in claim 33.

As discussed above for claim 1, Takahashi fails to disclose a rotatable component of the drive (which is the rotor of the motor) is rotatably supported on the screw, the rotor being coaxial with respect to the screw. Consequently, claim 33 is patentable. Withdrawal of the rejection is respectfully requested.

On page 5, item 9 of the Office Action, claim 29 is rejected under 35 U.S.C. §103(a) over Takahashi in view of U.S. Patent No. 4,180,146 to Airheart. The rejection is respectfully traversed.

Applicants respectfully submit that Airheart fails to disclose the discussed deficiencies of Takahashi, as discussed above. Thus, claim 29, which depends from claim 1, is patentable over Takahashi, Airheart, or their combination for at least the reasons discussed above and for the additional features it recites. Withdrawal of the rejection of claim 29 is respectfully requested.

On page 5, item 10 of the Office Action, claim 31 is rejected under 35 U.S.C. §103(a) over Takahashi in view of U.S. Patent No. 5,293,966 to Chaireire. The rejection is respectfully traversed.

Applicants respectfully submit that Chaireire fails to disclose the above discussed deficiencies in Takahashi. Thus, claim 31, which depends from claim 1, is patentable over Takahashi, Chaireire, or their combination for at least the reasons discussed above and for the additional features it recites. Withdrawal of the rejection of claim 31 is respectfully requested.

On page 6, item 11 of the Office Action, claim 32 is rejected under 35 U.S.C. §103(a) over Takahashi in view of U.S. Patent No. 6,089,359 to Tanaka. The rejection is respectfully traversed.

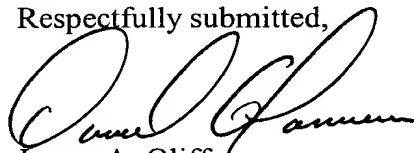
Applicants respectfully submit that Tanaka fails to overcome the above discussed deficiencies of Takahashi. Thus, Takahashi, Tanaka or their combination fails to disclose all of the features of claim 1, from which claim 32 depends, for at least the reasons discussed above and for the additional features it recites. Withdrawal of the rejection is respectfully requested.

II. CONCLUSION

For the reasons stated above, Applicants respectfully submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-33 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Daniel A. Tanner, III
Registration No. 54,734

JAO:DAT/cmf

Date: June 8, 2004

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
--